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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/477,511	01/04/2000	GABY MATSLIACH	2559/1F420-US2	9309

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EXAMINER	
JAROENCHONWANIT, BUNJOB	
ART UNIT	**PAPER NUMBER**
2141	5

DATE MAILED: 11/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/477,511	MATSLIACH ET AL.	
	Examiner	Art Unit	
	Bunjob Jaroenchonwanit	2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 January 2000* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *04 January 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

Claims Rejection under 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 1 recites the limitation "the first web server" in line 8-9. There is insufficient antecedent basis for this limitation in the claim. The first web server appears to refer to a first web site in line 5, for examination purpose, the examiner will read "the first web server" as "the first web site". Applicant is required to amend the claim in response to this Office Action.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1 and 3 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 5 of co-pending Application No. 09/422,387. Although the conflicting claims are not identical, they are not patentably distinct from each other because context of the claims' languages are closely similar. The mere difference is the instant claims are applied to co-branded community whereas the co-pending claims are applied for chatting in general.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by MacNaughton et al. (US. 6,020,884).

MacNaughton discloses a method and system for integrating online service community with foreign service. The system comprises: a community server; community browser; and community bookmarks; facilitate web navigation service, e-mail service and chatting service to members within community or communities (Col. 3, line 22-Col. 5, line 11).

9. As to claim 1, MacNaughton discloses the community server 18 provides chatting service to communities' members. Users who wish to become a member of each community, must provide information during sign up process to provide membership information, e.g., name address profile subject of interest, favorite web sites (Col. 9, lines 6-26), i.e., receiving users ID corresponding to their co-branded community. Further, MacNaughton discloses each community server supporting members interaction, thus second user ID is required for establishing interaction session between users thereby inherent. Furthermore, the system allows users to initiate chat session from community server's web page, web site address is required for linking to the web page thereby user ID inherent for establishing chat session (Col. 7, lines 37-56; Col. 4, lines 3-14). The aforementioned teaching teaches *receiving, from the first user, a first user ID corresponding to the first user, a co-branded community to which the user belongs and an address of a first web being visited by the first user; receiving, from the second user, a second user ID corresponding to the second user, a second co-branded community to which the second user belongs and the address of the firs, web server;*

Further, MacNaughton discloses users must create profile for each community they wished to join. One of community server will serve as a focal point at the time, will track users' entering chat-session, and the focal point server will present a list of member "Who 's Online" to users (Col. 9, lines 6-52), i.e., *providing, to the first user, at least an indication of the second user ID and the second co-branded community*;

Furthermore, MacNaughton discloses community server's determining notification activities, including information regard to creating and entering chat-room. In addition, MacNaughton discloses invitation and invitation-reply mechanisms, which community members can use for request-response to join a chat-session (Col. 9, lines 27-52; invite, invite-reply, Col. 15), *i.e., receiving, from the first user, a request to open one of a public chat session, a semi-public chat session and a private chat session with the second user; transmitting, to the second user, an indication that the first user has requested one of the public chat session, the semi-public chat session and the private chat session; and receiving, from the second user, an acceptance to enter the chat session designated by the first user.*

10. Claim 2, MacNaughton discloses system's presenting list of currently chat online members (Col. 10, lines 1-16). The teaching implied continuation of the chat session even though one of the participants leaves the chat session, i.e., *chat session may be continued when at least one of the users disconnected from the web site.*

11. Claim 3, MacNaughton discloses system's querying user database 44, determining if the user belongs to the community associated with the URL; including search feature for searching

community memberships, in which any member can be used to search users database for members from any communities (Col. 8, lines 42-67; Col. 10, lines 17-37), *i.e., receiving, from the first user, a query for information regarding other users in a co-branded community visiting the first web site; and searching a user database to determine which users in the co-branded community are visiting the first web site.*

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over MacNaughton et al. (US. 6,020,884).

As to claim 4, MacNaughton discloses the invention substantially, as claimed, as described in it/their base claim(s), including a profile capabilities allows users to access user profile, i.e., personal data. However, MacNaughton fails to express the personal data include a mood data.

Official Notice is taken (see MPEP 2144.03) that using mood data as personal indication data was well known in the art. The mood data has been used in several well-known chat soft wares such as ICQ or Avatar, such feature enhancing chatting feeling over network.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the use of mood data as a personal data MacNaughton because using mood data creating virtual reality effect, which allows members of the chat-session to recognize each other feeling. In doing so, the system would be more attractive to Internet users.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bunjob Jaroenchonwanit whose telephone number is (703) 305-9673. The examiner can normally be reached on 8:00-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on (703) 305-4815. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800.

Bunjob Jaroenchonwanit
Examiner
Art Unit 2141

/bj
November 18, 2002